

REMARKS

Claims 1-21 are subject to a restriction requirement. Claims 1 and 21 have been amended to include the word “and” between steps “c)” and “d)”. Claims 1, 6-9, 19, 21, and 22 have been amended to correct grammatical and typographical errors and for clarification. New claims 22-29 have been added. Support for the new claims can be found in the claims as originally filed, and at page 12, lines 7-10.

No new matter has been added by way of the amendments.

Restriction Requirement

The Examiner is requiring restriction under 35 U.S.C. §121 to one of the following two inventions:

- I. claims 1-18 and 21, drawn to a method of identifying a function of a gene sequence, classified in class 435, subclass 6; and
- II. claims 19 and 20, drawn to a method of altering the expression of one or more cellular factors in a cell or altering the phenotype of a cell by overexpressing or inhibiting the expression of a gene sequence, classified in class 435, subclass 455.

Applicant respectfully traverses the Restriction and submits that the asserted basis for the Restriction are insufficient. Applicant thus respectfully requests the Restriction be reviewed and either withdrawn or modified for the following reasons.

The Examiner has stated that the methods of Group I (claims 1-18 and 21) and Group II (claims 19 and 20) “comprise steps which are not required for or present in the methods of the other group[.]” The Examiner also asserts that “the operation, function, and effects of these different methods are distinct from each other. Therefore, the inventions of these different distinct groups are capable of supporting separate patents.” Applicant respectfully traverses based on the following.

Claims 19 and 20 disclose a method in which first the steps of claim 1 must be carried out, specifically, the function of a gene sequence must be identified. Then, further steps are taken to either alter the expression of one or more cellular factors in a cell or to alter the expression of a gene sequence. Therefore, there is overlap in the way in which the methods operate, function, and in their effect.

Therefore, as discussed above, Applicant believes that the reasons for restriction between Groups I and II are improper and requests that the restriction be withdrawn.

In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicant hereby elects Group I, claims 1-18 and 21, with traverse, for the reasons presented above. In addition, Applicant retains the right to petition from the requirement under 37 C.F.R. §1.144 (See M.P.E.P. § 818.03(c)).

Applicant expressly reserves the right under 35 U.S.C. § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application, or an application claiming priority from this application.

CONCLUSION

Applicant requests examination of the elected subject matter on the merits. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (858) 720-7961.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 397272000500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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